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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/698,930  | 11/03/2003  | Michael J. Iaconis   | 06181-918001        | 5058             |
| 26171   | 7590        | 11/30/2005           | EXAMINER            |                  |
| FISH & RICHARDSON P.C.<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | LOWEN, ALYSSA       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3711                |                  |

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                |  |
|------------------------------|-----------------|----------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)   |  |
|                              | 10/698,930      | IACONIS ET AL. |  |
|                              | Examiner        | Art Unit       |  |
|                              | Alyssa M. Lowen | 3711           |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 November 2003.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-46 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-46 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 03 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/3/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 9/3/04 is in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Priority***

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has complied with all conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number "510" for a shaft system.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference numbers "902" and "904" in Figures 9A and 9D.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(q) because Figure 2B contains lead lines without reference characters.

6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet

submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

7. The disclosure is objected to because of the following informalities: On page 7 paragraph 5, parts are referenced that can only be found in Figure 2A, therefore it should be added to the list of referring figures. On page 9 line 27, reference is made to Figures 8A-8G where 9A-9G was meant. On page 11 line 8 the crank gear is mislabeled as "1204" instead of "1202". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5, 7, 8, 14-17, 19, 25-31, 35-37, 39-45 rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (3199248). Regarding claim 1, Suzuki discloses a toy having a body (1), with a motor (2) within the body (Fig. 3) an appendage in the form of a wing (23) or beak (9) coupled to the body and actuated by the motor to move along a first path (column 3 line 20), a tail device (11) coupled to the body and actuated by the motor to move along a second path (column 2 lines 65-66) and a neck device (Fig. 2)

coupled to the body and actuated by the motor to move along a third path (column 3 line 5). Regarding claims 25 the toy has a body and a motor within the body with a first extension in the form of a wing (23) that is actuated by a motor to rotate about a first axis, a second extension coupled to the body in the form of a neck device (Fig. 2) that is actuated by the motor to rotate about a second axis which is perpendicular to that of the first and a third extension in the form of a tail device that is actuated by a motor to rotate about a third axis that is parallel with the first (Fig. 3). With regard to claims 2 and 26 the movement of the neck device, tail device and appendage occur simultaneously (column 3 lines 23-26). Regarding claims 3 and 27 the device has drive shafts (3,4) for coupling an appendage to the motor (Fig. 3). In regard to claims 4, 28 and 31 a cam (19) is attached to the driveshaft (4) such that rotation of the shaft rotates the cam. Regarding claims 5 and 29 an eccentric rod in the form of fingers (18) join the appendage to the cam. In regard to claim 7 a linkage rod (21) coupled to the body of the toy through the frame (14) and to a slot (23b) within the appendage where rotation of the cam causes the appendage to move along the first path (column 3 lines 15-26). Regarding claims 8 and 35 the driveshaft (3) couples the motor to the tail device. Regarding claims 14 and 30 the driveshaft (4) couples the motor to the neck device (Fig. 2). In regard to claim 15 a head (7) is attached to the neck device. Regarding claim 16 the neck device includes a hinge in the form of a pivot (17) attached to the body (Fig. 2) such that the neck device rotates about the hinge as the neck device moves along the third path (column 3 lines 3-6). In regard to claim 17 a follower (15) is attached to the neck device and coupled to the driveshaft (4) such that rotation of the

driveshaft moves the follower in a periodic pattern and causes the neck device to move along the third path (Fig. 3). Regarding claim 19 the toy has another appendage (23) shaped like the appendage (23) coupled to the body of the toy (Fig. 3). In regard to claim 36 the third extension or tail device (11) includes a hinge (10) attached to the body (Fig.2) that defines the third axis. Regarding claim 37 a follower (6) is attached to the third extension or tail device and coupled to the driveshaft (3) such that rotation of the driveshaft moves the follower in a periodic pattern and causes the third extension to rotate about the third axis (Fig. 3). With regard to claims 39 and 40 the toy has a body with a driving device including drive shafts (3,4) driven by a motor (2) where a first extension in the form of a wing (23) is coupled to a rotating device which includes a cam (19) and crank (4) to rotate the first extension about a first axis, a second extension in the form of a neck device (Fig. 2) is coupled to the rotating device (4) to rotate about a second axis which is perpendicular to that of the first and a third extension in the form of a tail device (11) that is coupled to a third rotating device or crank (3) to rotate about a third axis that is parallel with the first (Fig. 3). Regarding claim 41, the rotation of the first and second extensions occurs simultaneously (column 3 lines 23-26). In regard to claim 42 the first extension (23) couples to an eccentric rod (18) of a first surface of the rotating device or cam (19) by means of an extension rod (21). Regarding claim 43 a connector piece (15) within the body connects to the neck device and couples to the rotating device or crank (4) such that as the crank rotates the connector piece oscillates (column 3 lines 3-6). In regard to claim 44 a groove formed by a raised ridge (12) on a second surface of the rotating device or crank (4) receives a shaft of the connector

piece (Fig. 2). Regarding claim 45 the connector piece (15) connect to a lower piece of the second extension or neck device (Fig. 2) such that the neck device oscillates about the second axis as the connector piece oscillates due to rotation of the rotating device (column 3 lines 3-6).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki. Suzuki discloses the basic inventive concept substantially as claimed as described in claims 1 and 5 above but does not disclose expressly a pivot gear coupled to the body of the toy and including a post that couples to a slot within the appendage where gear teeth that mesh with gear teeth of the pivot gear extend from the cam such that rotation of the cam causes the gear to rotate and move the appendage along the first path. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to replace the rod (21) that connects the cam to the appendage with a pivot gear because Applicant has not disclosed that the pivot gear provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the rod because it connects to the cam such that rotation of

the cam causes the rod to move which in turn moves the appendage along the first path.

12. Claims 9-13 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki. Regarding claims 9-13 the reference discloses a tail device having a connector piece (6) coupled to a driveshaft in the form of a crank (3) such that rotation of the shaft oscillates the connector piece to produce the appearance of a wagging tail (column 2 lines 62-66). With regard to claims 32-34 the second extension is a neck device having a connector piece (15) within the body coupled to a driveshaft in the form of a crank (4) such that rotation of the shaft oscillates the connector piece to oscillate the neck about the second axis (column 3 lines 3-6). Suzuki does not disclose expressly a cam attached to the driveshaft with a groove for receiving the shaft of a connector piece for either the neck or tail devices where rotation of the cam causes the connector to oscillate which in turn moves the neck or tail. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to replace the cranks with cams because Applicant has not disclosed that cams provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with cranks because they perform the exact same function as the cams and even reduce the number of parts needed in construction of the device.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Saitoh (5316516). Suzuki discloses the basic inventive concept, substantially

as claimed, as applied to claim 1 above with the exception of a controller located within the body that is coupled to the motor and a sensor connected to the controller in order to send a signal to the controller to cause the motor to operate. However, Saitoh discloses a bird toy having a sensor connected to a controller in order to operate the motor (Fig. 7) showing this feature to be old in the bird toy art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention from the teaching of Saitoh to modify the toy of Suzuki to include a sensor and controller in order to increase the amusement value of the device since the movements will be more interesting and surprising creating a more realistic figure.

14. Claims 20-21 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki. Suzuki discloses the basic inventive concept, substantially as claimed as applied to claims 1 and 25 above, with the exception of the appendage or first extension in the form of a wing moving along a non-circular path. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the appendage move in a non-circular path because Applicant has not disclosed that the movement in a non-circular path provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the appendage moving in a circular path since it creates a more realistic and natural looking movement of the animal.

15. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of Iwaya (4389811). Suzuki discloses the basic inventive concept as

applied to claim 1 above, with the exception of a flexible skin surrounding the body of the toy where the flexible skin surrounds the appendage of the toy and moves as the appendage moves. Iwaya discloses a covering member (83) of feathers secured onto the bird toy showing this feature to be old in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention from the teaching of Iwaya to modify the device of Suzuki to include a flexible skin or covering over the toy which would be capable of moving with the toy in order to give the toy a more realistic and lifelike appearance. Regarding claim 23 the reference does not expressly disclose the use of pile in the flexible skin. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use pile because Applicant has not disclosed that using pile provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the feather skin since it would give a more realistic appearance to the bird.

16. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki. Suzuki discloses the basic inventive concept, substantially as claimed with the exception of the second extension having the appearance of a wagging tail. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the second extension take the form of a wagging tail because Applicant has not disclosed that the second extension being a wagging tail provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's

invention to perform equally well with the second extension being a neck device because the device still includes a wagging tail but as the third extension instead of the second.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chan (6273782) discloses a robotic dog toy. Hornsby (20010029147) discloses another robotic dog toy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AML

EUGENE KIM  
PRIMARY EXAMINER